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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,634	08/24/2001	Jeffrey Green	NAI1P092/01.050.01	1385

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EXAMINER	
CLOUD, JOIYA M	
ART UNIT	PAPER NUMBER
2144	
MAIL DATE	DELIVERY MODE
08/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/935,634	GREEN ET AL.	
	Examiner	Art Unit	
	Joiya M. Cloud	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-15,23-30,32,34,36-39 and 41-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12-15,23-30,32,34,36-39 and 41-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/05/2008; 09/21/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications 04/24/2008. Claims 1-10, 12-15, 23-27, 28-30, 32, 34, 36-39 and 41-44 are PENDING. Applicant's arguments have been carefully considered but are not persuasive.

IDS

Examiner acknowledges the IDS submitted 09/15/2005 has been properly considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims** 1-6, 8-10, 12-15, 23-27, 28-30, 32, 34, 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al., **(U.S. Patent No. 6,901,519)** in view of Hargraves et al. **(US Provisional Application No. 60/289,814)**

As per claim 1, Stewart discloses the invention substantially as claimed. Stewart teaches a method carried out by a computer when executing computer-readable program code, the method comprising: receiving a certain electronic file intended for delivery from a sender to an intended recipient, the certain electronic file having a first file format having a first file extension and containing a computer virus (Stewart, col.3, l.60-col.4, l.3); and prior to the certain

electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format having a second file extension that is different from the first file extension of the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient (Stewart, col.3, l.56-64); wherein it is determined whether the certain electronic file represents a potential risk to security of a computer system (Stewart, col.3, l.45-55); and said converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer systems (Stewart, col.3, l.35-39).

However, Stewart does not explicitly disclose wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML, file format without scripts.

Hargraves teaches wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML, file format without scripts **(see col. 5, lines 10-21 where Hargraves teaches the first condition of the *if* limitation in the claim- Document 17a such as a Microsoft Word document, is converted to an RTF (ASCII character), as an "existing other-format document")**.

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporate Stewart's teachings to the teachings of Hargraves for the purpose of permitting "the associated document to be reproduced…as a suitable file format."

As per claim 2, Stewart further discloses the method of claim 1, the certain electronic file being an attachment to an electronic mail sent over a network **(Stewart, col. 3, l.28-30).**

As per claim 3, Stewart further discloses the method of claim 2, the network including the internet **(Stewart, col.3, l.30-31).**

As per claim 4, Stewart further discloses the method of claim 1, said receiving occurring at a desktop computer of the intended recipient **(Stewart, fig.1).**

As per claim 5, Stewart further discloses the method of claim 1, said receiving occurring at a server computer **(Stewart, col.3, l.28-30, fig.1).**

As per claim 6, Stewart further discloses the method of claim 1, said receiving occurring at a gateway computer **(Stewart, col. 3, l.12-14) .**

As per claim 8, Stewart further discloses the method of claim 1, said converting occurring at a server computer **(Stewart, col.4, l.28-30).**

As per claim 9, Stewart further discloses the method of claim 1, said converting occurring at a gateway computer **(Stewart, fig. 1).**

As per claim 10, Stewart further discloses the method of claim 1, said converting occurring prior to the intended recipient receiving the certain electronic file **(Stewart, col. 3, l.16-22).**

As per claim 12, Stewart further discloses the method of claim 1, said determining whether the certain electronic file represents the potential risk comprising: determining if the certain electronic file contains the computer virus

(Stewart, col. 3, l.45-55).

As per claim 13, Stewart further discloses the method of claim 1, said determining whether the certain electronic file represents the potential risk comprising: conducting a heuristic scan of the certain electronic file **(Stewart, col. 4, l.1-10).**

As per claim 14, Stewart further discloses the method of claim, the certain electronic file being a first electronic file, further comprising: receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus **(Stewart, col.5, l.14-18)**, in which the additional file that are unexpected changed including name, content and extension); and prior to the second electronic file being made available for viewing by the another intended recipient, converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient **(Stewart, col.5, 13-14, a special validation process is performed, see fig. 3).**

As per claims 15, Stewart further discloses the method of claim 1, the computer virus including a macro virus **(Stewart, col.4, l.1-25),**

As per claim 18, Stewart further discloses the method of claim 16, the second file format being the ASCII file format file **(Stewart, col.3, l.60-61, alphanumeric only text file).**

As per claim 19, Stewart further discloses the method of claim 16, the

second file format being the TXT file format **(Stewart, col.3, l.60-61, alphanumeric only text file).**

As per claim 20, Stewart further discloses the method of claim 1, the second file format being a file format having text without scripts **(Stewart , col.4, l.38-40).**

As per claim 21, Stewart further discloses the method of claim 1, the certain electronic file being at least one of a word processing file, a spreadsheet file, a database file, a graphics file, a presentation file, a compressed file, and a binary executable file **(Stewart, col.4, l.24-27).**

As per claims 24-26 have similar limitation as claims 1 and 12. Therefore, claims 24-26 are rejected under Stewart for the same reason set forth in the rejection of claim 1 and 12.

As per claim 27, Stewart further discloses the method of 24, said determining comprising: determining whether content of the electronic file reflects a potential computer virus **(Stewart, col. 3, l.35-44).**

As per claims 28-30, 32, and 35 have similar limitation as claims 1,2, 10-12, 15, and 21. Therefore, claims 28-30, 32, and 35 are rejected under Stewart for the same reason set forth in the rejection of claim 1,2,10-12, 15, and 21.

As per claims 34, Stewart further discloses the method of claim 28, the computer virus being a macro virus **(Stewart, col.4, l.1-25).**

Claim Rejections - 35 USC § 103

Claims 7 and 36-39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart-Hargraves in view Scwabe et al **(US 2003/0028686 A1).**

Stewart-Hargraves discloses the invention substantially as claimed. However, Stewart-Hargraves does not explicitly disclose converting occurring at a desktop computer of the intended recipient.

Schwabe teaches converting occurring at a desktop computer of the intended recipient **(paragraph [0042], see also paragraph [0029] for further detail).**

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporate Stewart-Hargrave's teachings to the teachings of Schwabe for the purpose of providing a "suitable platform" for conversion of files **(paragraph [0042]).**

As per claims 36-37 have similar limitation as claims 1, and 7. Therefore, claims 36-37 are rejected under Stewart for the same reason set forth in the rejection of claim 1, and 7.

As per claim 38, Stewart further discloses the apparatus of claim 36, said computer being a server computer of a local area network **(Stewart, col.21, l.20).**

As per claim 39, Stewart further discloses the apparatus of claim 36, said computer being a gateway computer **(Stewart, fig 1).**

42]).

Response to Arguments

A). Examiner has failed to provide a specific prior art citation to address applicant's claimed technique "wherein it is determined if the first file format is one of a word processing file format type and a graphics file format is one of a word processing file format type and a graphics file format type...the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type".

As to the above point A), Examiner respectfully disagrees. The instant claims recite two embodiments, the first requiring wherein "if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts" and the second embodiment requiring wherein "if it is determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, an HTML file format without scripts, a JPEG file format if it is determined that the first file format is the graphics file format type." It should be noted that such a conditional recitation requires that only one condition is met, therefore Examiner has relied upon the first conditional embodiment as recited in the claim. Examiner clarifies the reference to the prior art citation which discloses the limitation in the following section of the disclosure (see col. 5, lines 10-21 where Hargraves teaches the first condition of the *if* limitation in the claim- Document 17a such as

a Microsoft Word document, is converted to an RTF (ASCII character), as an "existing other-format document")

B). Examiner fails to teach or suggest "converting occurring at a desktop computer of the ***intended recipient***".

As to the above point B), Examiner respectfully disagrees. Examiner submits that Applicant's limitation regarding *intended recipient* can be interpreted in two ways. The *intended recipient* can refer to merely the final destination of a communication between a sender and receiver. However, the *intended recipient* may also refer to any intermediary point of which the communication passes before arriving at the final recipient, as the intermediary points are also valid *intended recipients*. As such, Examiner has interpreted the *intended recipient* to be the desktop computer at which the conversion takes place disclosed by Schwabe (see above rejection). Examiner suggests Applicant clearly distinguish with supporting claim language what Applicant intends as the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMC

/William C. Vaughn, Jr./

Supervisory Patent Examiner **August 18, 2008**